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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/222,460	12/29/98	HAMMERMAN	M A-64236-3-RF

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EXAMINER

MOEZIE, F

ART UNIT	PAPER NUMBER
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1653

DATE MAILED:

10/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

file **Office Action Summary**

Application No.
09/222,460

Applicant(s)
Hammerman, Etal

Examiner
F. T. Moezie

Group Art Unit
1653

☒ Responsive to communication(s) filed on Aug 21, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-21 is/are pending in the application.

Of the above, claim(s) 2, 10-16, 18, 19, and 21 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 3-9, 17, and 20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-21 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8 & 9

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Serial Number: 09/222,460

Art Unit: 1653

DETAILED ACTION

CLAM STATUS

Claims 1, 3-9, 17 and 20 are examined in this Office action to the extent that they read on VEGF as the elected growth factor.

In response to the Restriction Requirement, Office Action mailed 01 June 2000, paper no. 11, applicant elected Invention of Group IV, claim 17, VEGF, without traverse.

Applicant states that "with the understanding that if prior art permits, we will also be entitled to generic claims 1, 3-9 and 20". Applicant's attention is directed to the paragraph immediately following the Grouping of the Inventions and the claims (page 3) wherein it is clearly stated that "Claims 1, 3-9 and 20 are examined insofar as *they read on the elected invention as set forth above* and upon allowance of an invention they will be considered for allowance *provided that they are rewritten and are commensurate in scope with the elected-allowed invention.*"

REJECTION - 35 USC 112, SECOND PARAGRAPH

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1, 3-9, 17 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are vague and indefinite as to the proportions or amounts of VEGF and duration of time necessary for achieving the expected results.

Moreover, how is the end result monitored and what is manifested by the method?

In claim 9, the term "such that" render the claim indefinite as to how? The critical method steps and/or observations are missing from the claim.

REJECTION - DOUBLE PATENTING

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1, 3-9, 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 5,976,524 in view of Robert, et al., In American Physiological Society, pp F744-753, 1996.

Robert et al teach that "VEGF is a potent cell-specific mitogen, enhances cell migration --- vasculogenesis as well" page F747, second column. Moreover, the article discloses "we believe that in response to VEGF some of these cells also take up positions within vasculature ---" Table 1 and second column at page F751. See the entire document.

It would have been obvious to incorporate VEGF in the method steps of the Patent and expect improved results at the time of the invention.

CONCLUSION

No claim is allowed.

Any inquiry concerning this communication should be directed to F.T. Moezie at telephone number (703) 305-4508.

F.T. Moezie
PRIMARY EXAMINER
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